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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/101,864 07/21/98 CAVANAGH M 20253-60398

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QM12/0913

EXAMINER

FOSTER, J

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

09/13/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/101,864**

Applicant(s)  
**Cavanagh**

Examiner  
**J. Foster**

Group Art Unit  
**3728**



☒ Responsive to communication(s) filed on Jul 12, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 2, 4-11, and 15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 2, 4-11, and 15 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. It is noted that although the examiner had indicated allowable subject matter in claims 12 and 16 (claim 12 would have been allowable if completely made in independent form), Applicant has chosen to cancel these claims.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2, 5, 6 and 15 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Haaser (3,738,251). In the reference of Haaser, the basin 13 may be considered to define a recess, and the drain boards 11 may be considered to define inclined guide means. Although intended for photographic print developing, the recess 13 is capable of receiving a sharp surgical instrument/scalpel sized to be received therein, to the extent claimed by Applicant in since Applicant does not positively recite the instrument or steps in the claims, this capability of the recess of Haaser meets what Applicant has claimed in this regard.

The deepened and widened portion 15 of the recess defines an access means which would facilitate the user to grasp the handle of the scalpel.

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4. Claims 4, 9, 10 and 15 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Strauss (5,129,615). The holder 10 of Strauss includes a recess at 26 and an inclined guide means located at flange 32. Although intended for an umbrella, the recess 26 is capable of receiving a sharp surgical instrument/scalpel sized to be received therein, to the extent claimed by Applicant. Since Applicant does not positively recite the instrument or the steps in the claims, this capability of the recess of Haaser meets what Applicant has claimed in this regard. Arms 14,16 constitute handle means since they can be gripped by a person.

5. Claims 2, 7, 8 and 15 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (5,368,580). In the reference of Suzuki, a recess is provided at 13. Inclined guide means are shown in Figures 1, 2 3a, 3b, and 5 as being located at the mouth of the recess 13. The recess 13 widens just below the opening thereof and therefore provides barrier means. The holder of Suzuki is for holding a sharp surgical instrument, such as a syringe needle. However, the device is capable of holding a thin scalpel.

6. Claims 2, 7, 8, 11 and 15 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Kiyoshi et al (5,348,152). In the reference of Kiyoshi et al, recesses are provided by grooves 15, and inclined guide means are provided at the top of the sidewalls 3. Elements 5 define barrier means.

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7. Applicant's arguments filed July 12, 1999 have been fully considered but they are not persuasive. All of the arguments made by Applicant in response the first Office action rely on the size, dimension and orientation of the scalpel within the container. However, in response the Examiner's assertion in the first Office action that the scalpel is not positively recited in the claims (i.e., it is instead recited as function or intended use), Applicant neither rebuts this assertion nor amends the claims to positively recite the scalpel in the container. Therefore, it is now asserted that all of the arguments made by the Applicant, which rely on the interrelationship between the scalpel (including its handle and blade) and the container, including the orientation of the scalpel and the comparative size of the scalpel to the container recess, lack support in the claims and are therefore without merit. The reason for this is based upon the clear fact that scalpels including their blades and handles, may be made with any size, shape and form. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" what is disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Finally, it has been held that a recitation with respect to the manner in which a claimed

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apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). See MPEP 2114.

Inasmuch as Applicant has failed to factually demonstrate that the rejection reference devices are incapable of holding any scalpel in the manner as claimed (in function), Applicant has not persuasively rebutted the rejections made.

For example, Applicant apparently argues against the rejection of Kiyoshi (et al) by indicating that the barber's spare blade 2 does not compare with the recess 15 of Kiyoshi in the manner as Applicant has claimed between the major and minor cross-sectional dimensions of a scalpel with respect to the cross-sectional dimensions of the scalpel recess. However, inasmuch as Applicant is not positively reciting the scalpel in the recesses in the claim, the rejection need not rely on the spare blade 2 of Kiyoshi to show anticipation, and Applicant's argument, then, is only sensible if Applicant can persuasively indicate that Kiyoshi's device and its recess are incapable of meeting this function claimed by Applicant. The examiner asserts that Applicant cannot show this because the groove 15 of Kiyoshi includes a portion shown in Kiyoshi's Figure 3, which has a depth smaller than its width and which is capable of holding a scalpel with the appropriate dimensions in the manner claimed by Applicant, insofar as claimed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. To insure prompt handling of correspondence after final rejection, it should be addressed **BOX AF**.

For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --  
Clerical supervisors:

Ebony Smith . . . . . (703)305-3570

For matters regarding examination -- Examiner:

Jim Foster . . . . . (703)308-1505

For faxing of correspondence:

Draft amendments only-(703)308-7769

(Examiner should be notified of fax)

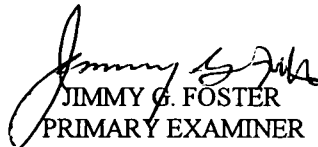
Formal correspondence-(703)305-3579 or 305-3580

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Before the Examiner . (703)308-1505

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JIMMY G. FOSTER  
PRIMARY EXAMINER  
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5/11/99

JGF  
September 11, 1999